

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of : Olaf SIMON et al.  
International Application No. : PCT/EP2004/013280  
International Filing Date : November 23, 2004  
U.S. Serial No. : 10/583,479  
For : SYSTEM

**Mail Stop PCT**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NOTIFICATION OF MISSING  
REQUIREMENTS UNDER 35 U.S.C. 371 AND DECISION ON PETITION**

S I R :

In response to the Notification of "Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (the Notification) dated February 16, 2006, and the Decision on Petition under 37 CFR 1.181 dated October 24, 2007 (the Decision) applicant submits the following:

- a. Executed Declaration,
- b. A copy of the Decision on Petition under 37 CFR 1.181 dated October 24, 2007 and
- c. A copy of the Notice to File Missing Parts of Nonprovisional Application dated February 16, 2006;

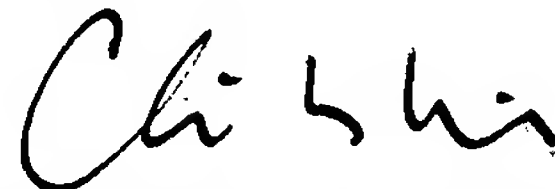
The Commissioner is hereby authorized to charge payment of the 37 C.F.R. § 1.16(f) surcharge fee of \$130.00 for a small entity to the deposit account of Kenyon & Kenyon LLP, deposit account number 11-0600.

The Commissioner is also authorized to charge any additional fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit account No. 11-0600. A duplicate of this sheet is enclosed for charging purposes

11/19/2007 GFREY1 00000086 110600 10583479  
01 FC:1617 130.00 DA

Date: November 15, 2007

Respectfully submitted,



Clifford A. Ulrich, Reg. No. 42,194

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## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
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 Alexandria, Virginia 22313-1450  
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/583,479	Olaf Simon	12604/25

INTERNATIONAL APPLICATION NO.
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PCT/EP04/13280

I.A. FILING DATE	PRIORITY DATE
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11/23/2004

12/19/2003

26646  
 KENYON & KENYON LLP  
 ONE BROADWAY  
 NEW YORK, NY 10004

CONFIRMATION NO. 4951

371 FORMALITIES LETTER



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Date Mailed: 02/16/2007

### NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Copy of the International Application filed on 06/19/2006
- English Translation of the IA filed on 06/19/2006
- Copy of the International Search Report filed on 06/19/2006
- Preliminary Amendments filed on 06/19/2006
- Oath or Declaration filed on 06/19/2006
- Request for Immediate Examination filed on 06/19/2006
- U.S. Basic National Fees filed on 06/19/2006
- Substitute Specification filed on 06/19/2006
- Assignment filed on 06/19/2006
- Priority Documents filed on 06/19/2006
- Power of Attorney filed on 06/19/2006

The applicant needs to satisfy supplemental fees problems indicated below.

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
  - does not identify the application to which it is directed.
- To avoid abandonment, a surcharge (for late submission of filing fee, search fee, examination fee or oath or declaration) as set forth in 37 CFR 1.492(h) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.

**SUMMARY OF FEES DUE:**

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Surcharge.

**ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 32 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.  
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

**If you are not using EFS-Web to submit your reply, you must include a copy of this notice.**

JOHN L ANDERSON

Telephone: (703) 308-9140 EXT 211

**PART 1 - ATTORNEY/APPLICANT COPY**

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/583,479	PCT/EP04/13280	12604/25



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

24 OCT 2007

KENYON & KENYON LLP  
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NEW YORK, NY 10004

In re Application of SIMON et al  
U.S. Application No.: 10/583,479  
PCT Application No.: PCT/EP2004/013280  
Int. Filing Date: 23 November 2004  
Priority Date Claimed: 10 December 2003  
Attorney Docket No.: 12604/25  
For: SYSTEM

DECISION

This is in response to applicant's "Response to Notification of Missing Requirements Under 35 U.S.C. 371" filed 17 May 2007, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

**BACKGROUND**

On 23 November 2004, applicant filed international application PCT/EP2004/013280, which claimed priority of an earlier Germany application filed 10 December 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 14 July 2005. The thirty-month period for paying the basic national fee in the United States expired on 19 June 2006.

On 19 June 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a copy of an execute declaration submitted in the international application under PCT Rule 4.17(iv).

On 26 February 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that the declaration filed 19 June 2006 does not identify the application to which it is directed.

**DISCUSSION**

A review of the application file reveals that the declaration filed 19 June 2006 is present. A declaration under PCT Rule 4.17(iv) need not identify the international application number if

the declaration is filed with the international application papers on the international filing date. A review of the declaration indicates that joint inventor Josef Schmidt appears to have executed the declaration on 27 November 2004, which is later than the international filing date. Assuming this is correct, a complete declaration could not have been filed on the international filing date. Therefore, for the purposes of the national stage in the United States, the declaration under PCT Rule 4.17(iv) does not properly identify the application to which it is directed, and the mailing of the Notification of Missing Requirements on 26 February 2007 was proper.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

Because the filing of the present petition is deemed to be a bona fide attempt to respond to the Notification of Missing Requirements, applicant is hereby given a time limit of ONE (1) MONTH to file a proper reply. Extensions of time are NOT available. Failure to time file a proper reply will result in ABANDONMENT of the application. A proper reply would include one of the following: (1) a properly executed oath/declaration, (2) adequate proof that the declaration under PCT Rule 4.17(iv) was filed on the international filing date along with an explanation as to the date of execution by joint inventor Schmidt, or (3) an appropriate petition under 37 CFR 1.47 in the event one or more of the joint inventors is not available to sign.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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